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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/066,323	01/31/2002	Carl W. Gilbert	329.1001-U	9839

7590 12/29/2003

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EXAMINER

OH, TAYLOR V

ART UNIT	PAPER NUMBER
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1625

10

DATE MAILED: 12/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/066,323

Applicant(s)

GILBERT ET AL.

Examiner

Taylor Victor Oh

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 13,15,17-21,23 and 26-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12,14,16,22,24,25 and 31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on _____ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

The Status of Claims:

Claims 1-31 are pending.

Claims 13, 15, 17-21, 23, and 26-30 have been withdrawn from consideration.

Claims 1-12, 14, 16, 22, 24, 25 and 31 have been rejected.

DETAILED ACTION

1. Claims 1-12, 14, 16, 22, 24, 25 and 31 are under consideration in this Office Action.

Priority

2. It is noted that this application claims benefit of 60/284,308 filed on 04/17/2001.

Drawing

3. It is noted that the drawings have been accepted by the Examiner.

Election/Restrictions

Applicant's election with traverse of Group I (claims 1-12, 14, 16, 22, 24, 25 and 31) in Paper (10/15/2003) is acknowledged.

Claims 13, 15, 17-21, 23, and 26-30 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to nonelected groups II-IV, there being no

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allowable generic or linking claim. Election was made **with** traverse in Paper (10/15/2003).

The traversal is on the ground(s) that the compounds of Group IV are conjugates linked to the compositions of formula I found in Group I; therefore, it would not be an undue burden upon the Examiner to search and consider the compositions of Groups I and IV at the same time; with respect to II and III, the fact that D and Z are different from the moieties identified in Group I is of secondary concern for search purposes due to those limitations still in the cinnamate core; with respect to Group V, the method is for treating a mammal with an effective amount of a composition of claim 1 in Group I, which is overlap of the search in conducting the search of Group I.

This is not found persuasive because if there are at least more than two distinct, clearly different classes involved in the search of the application, the search becomes a serious burden whether or not they are sharing a common core due to the various conjugate side chains related to amino acids, enzymes, peptides, and along with the method of treating the mammal with the effective amount of the composition. Furthermore, M.P.E.P. Section 808.02 gives legitimate reasons for the Examiner to insist on restriction such as the case of separate classification, which indicates that "each distinct subject has attained recognition in the art as a separate subject for the inventive effort, and also a separate field of search ." Therefore, the Examiner has a right to do so in this case.

The requirement is still deemed proper and is therefore made FINAL.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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Claims 1-12, 14, 16, 22, 24, 25 and 31 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-2, 8-16, 26 and 34 of copending Application No. 10/066,306. Although the conflicting claims are not identical, they are not patentably distinct from each other because the differences between the claims of the instant invention and the claims of Application No. 10/066,306 are as follow:

in the claims 1-2, 8-16, 26 and 34 of copending Application No. 10/066,306, some limitation of claim 2 is written as a dependent claim instead of being part of the independent claim 1 as in the instant invention. Claim 34 employs the generic formula to describe the specific amino group selected from the substituent Z1 groups attached to the benzene core compound, whereas claim 31 describes the substituent of the specific amino group attached to the benzene core compound. The rest of claims in copending Application are the same as those in the instant invention.

This difference can not impart patentability because the reorganizing limitations of the claims are an obvious step. Therefore, it would have been obvious to the skilled artisan to be motivated to reorganize the claimed limitations in order to emphasize the particular aspects of the current invention.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Taylor Victor Oh whose telephone number is 703-305-0809. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alan Rotman can be reached on 703-308-4698. The fax phone number for the organization where this application or proceeding is assigned is 703-308-2742.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

Margaret Seaman
1/2/21/03

Margaret Seaman
D. MARGARET SEAMAN
PRIMARY EXAMINER